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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,817	09/17/2003	Walter D. Buist	74577-077	8936
21890 7590 06/24/2010 PROSKAUER ROSE LLP One International Place Boston, MA 02110			EXAMINER MURDOUGH, JOSHUA A	
			ART UNIT 3621	PAPER NUMBER
			NOTIFICATION DATE 06/24/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mahmed@proskauer.com  
NYPatentAdmin@proskauer.com

# Office Action Summary

**Application No.**

10/666,817

**Applicant(s)**

BUIST, WALTER D.

**Examiner**

JOSHUA MURDOUGH

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Prosecution Reopened***

1. On 24 September 2007, Applicants filed an Appeal Brief ("September 2007 Appeal").
2. On 29 December 2008, the Board of Patent Appeals and Interferences ("Board") rendered their decision on the appeal ("2008 Decision") affirming the Examiner.
3. On 26 February 2009, Applicants filed a request for rehearing ("2009 Rehearing Request").
4. On 29 June 2009, the Board decided the 2009 Rehearing Request ("June 2009 Decision"). The rehearing was granted only as to denominating a new ground under 37 C.F.R. § 41.50(b).
5. On 27 August 2009, Applicants filed an amendment and indication that wish to reopen prosecution.
6. Because the June 2009 Decision denominated the grounds of the 2008 Decision as new grounds and because Applicants' wish to reopen prosecution, prosecution is reopened.

***Acknowledgements***

7. This action is responsive to Applicants' amendments received 16 November 2009.
8. This action has been assigned paper number 20100609 for reference purposes only.
9. Claims 1-24 are pending.
10. Claims 1-24 have been examined.

***Claim Objections***

11. Claims 1, 5, 7 are objected to because of the following informalities:
  - a. in lines 9-10 of claim 1 the phrase "the the" is recited, which is understood to be a typographical mistake;
  - b. the phrase "the the" is also present in line 3 of claim 5;
  - c. in lines 7-8 of claim 7 "the the" is again recited;
12. Appropriate correction is required.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
14. Claims 1-6 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.
15. Claim 1 has been amended to recite "said computing repository device having been specifically programmed to ...store information concerning a coded meaning for the message that is defined to be different than the [] field delimited protocol meaning." The only discussion of storing in the original disclosure is in the specification in [0036] and [0052] where it talks about storing the messages. There is no discussion of storing "information concerning a coded

meaning" in either of these passages. Therefore, it is the Examiner's position that the original disclosure does not support "said computing repository device having been specifically programmed to ...store information concerning a coded meaning for the message that is defined to be different than the [] field delimited protocol meaning."

16. Claim 22 has been amended to recite "a database that stores information concerning the coded meaning." The Examiner has reviewed the original disclosure and can only find two instances of a database (Specification, [0036] & [0052]). Neither of these passages discusses "information concerning the coded meaning." Therefore, it is the Examiner's position that the original disclosure does not support "a database that stores information concerning the coded meaning" as claimed in claim 22.

*Claim Rejections - 35 USC § 103*

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hausman (US 2004/0030632) in view of Reuter (US 2002/0049666).

19. As to claims 1, 7, 22, and 23, Hausman shows:

d. A method for securely communicating financial information, comprising:

- c. Receiving [0012] at a repository computing device 101 a message communicated according to a field delimited communication protocol (FIX, [0041]), the message comprising a financial data field ("data input field," [0022]) and a field value corresponding to the financial data field ("user may enter data," [0022]), said computing repository device having been specifically programmed to facilitate financial transactions ("The system comprises a computer readable medium or media having programming stored thereon for causing the computer system to receive from a user of the computer system, such as a trader employed by a securities trading firm, terms for a proposed trade in a financial interest," [0012]) and receive (Id.) and store information concerning a coded meaning ("Data so entered is encoded electronically for processing by the computer system," [0057]) for the message that is defined to be different than the the field delimited protocol meaning [0075];
- f. and interpreting said message according to a the coded meaning (Inherent in [0075]) (the Examiner notes this can still be a mental process, See 2008 Decision, Page 7, Paragraph 3).
20. Hausman does not expressly show:
- g. using information stored in the repository computing device in conducting a financial transaction.
21. However, Reuter shows the execution of a transaction [0003] using data communicated according to the FIX protocol [0022]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Hausman to include the execution of the transaction for which the data was received and stored. Because both

inventions use the same protocol, the addition of the execution as shown by Reuter should be essentially “plug-and-play” because the data would already be in a format understood by the execution program/devices. Because the data being sent for execution is in the known (FIX) format, the result would be exactly as it was in the Reuter invention.

22. As to claims 13 and 24, Hausman shows:

- h. A method for securely communicating financial information using a repository computing device, comprising:
  - i. receiving [0012] at the repository computing device **101** over a first electronic computer network (Network 100 and Client 1, figure 1) a first message (message through Client 1, Figure 1), said first message in a field delimited communication protocol pursuant (FIX, [0041]) to which the first message comprises a first financial data field (“data input field,” [0022]) and a first field value corresponding to the first financial data field (“user may enter data,” [0022]);
  - j. transmitting over a second electronic computer network (Network 100 and Client 2, figure 1), a second message (message through Client 2, Figure 1), using the repository computing device **101**, said second message in the field delimited communication protocol (FIX, [0041]) comprising a second financial data field (“data input field,” [0022]) and a second field value corresponding to the second financial data field (“user may enter data,” [0022]); and
  - k. at least one of said first and second messages being interpreted by the repository computing device as encoded [0075], wherein each encoded message is intended to have

a meaning ("Data so entered is encoded electronically for processing by the computer system," [0057]) different from the field delimited communication protocol meaning [0075], wherein, said first and second electronic network and said first and second messages are not necessarily distinct (may or may not be distinct, network 100 is the same in both, but the client devices are different, Figure 1).

23. Hausman does not expressly show:

l. a repository computing device specifically programmed to facilitate financial transactions connected one or more order management system computing devices.

24. However, Reuter shows a CoHost Server **107** or private network that manages the communications [0035]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Hausman to include one or more order management system computing devices connected to the repository computing device because the additional devices would be connected using known protocols and would function in a predictable manner.

25. As to claims 2, 8, and 14, Hausman further shows:

m. the field delimited communication protocol is the Financial Information Exchange (FIX) Protocol, or a protocol derived therefrom [0041].

26. As to claims 3, 9, and 15, Hausman further shows:

n. the message communicates a number of shares ordered or offered (Figures 4 & 5).



27. As to claims 4 and 10, Hausman further shows:
- o. the financial data field is a FIX tag 38 entry (Id.).
28. As to claims 5, 11, and 16, Hausman further shows:
- p. the coded meaning represents a number of shares of a financial transaction to which the message pertains that is different than the the number of shares the message would represent under the field delimited communication protocol (Figures 4, 5 and [0054]).
29. As to claims 6, 12, and 17, Hausman further shows:
- q. the message corresponds to an Indication of Interest (IOI) for a number of shares [0060] & [0067].
30. As to claim 18, Hausman further shows:
- r. determining whether corresponding entries first field value and the second field value match [0054]-[0056]; and
  - s. if the match is successful, transmitting a notification to one or more broker/dealers [0056].
31. As to claim 19, Hausman further shows:
- t. the transmitted notification is not encoded (it is not shown to be encoded).

32. As to claim 20, Hausman further shows:

- u. said first message is encoded, and wherein said transmitted notification is made to a plurality of receivers, further comprising:
- v. receiving from a receiver a reply to said second message (reply indicates if the proposal was accepted or not, 264); and
- w. determining whether the first field value and the second field value match [0056].

33. As to claim 21, Hausman further shows:

- x. if the match is successful, transmitting a notification to one or more broker dealers [0056].

### ***Response to Arguments***

34. Applicant's arguments filed 27 August 2009 have been fully considered but they are not persuasive.

35. Applicants argue:

36. “[T]he Hausman system is not capable, *without modification*, of performing claimed functions of communicating, storing, interpreting, and encoding messages communicated in a field delimited communication protocol to have coded meanings different than the standard, publicly-known meaning under the field delimited communication protocol” (Remarks, Page 12, Paragraph 1).

37. Examiner's response:

38. First, the Examiner notes that Applicant is paraphrasing the claim limitations. The claims do not recite "communicating, storing, interpreting, and encoding messages communicated in a field delimited communication protocol to have coded meanings different than the standard, publicly-known meaning under the field delimited communication protocol."

39. The Examiner respectfully notes that the Board indicated in the 2008 Decision found that the interpreting step is not required to be performed by the computer (Page 7, Paragraph 3). Additionally, the Board found in the 2008 Decision that a human mind is capable of following a mental algorithm, such as multiply all order values by 10 (Finding of Fact 5, Page 4). The Board further stated "the recited interpreting step of the method claims can be accomplished by human analysis to meet the claim limitation. Since the system in Hausman communicates to a recipient values such as "30" for the price term in field 352 in a proposal, the recipient is fully capable of interpreting this value as thirty-its standard, publicly-known meaning. Alternatively, the recipient may interpret the value to mean three hundred "30"x10- differently from a publicly-known meaning, depending on the understanding the recipient has with the trader" in the 2008 Decision (Pages 7-8, Paragraph spanning).

***Conclusion***

40. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

41. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

42. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

y. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112 1<sup>st</sup> paragraph.

z. Independent of the requirements under 35 U.S.C. § 112 1<sup>st</sup> paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an

objection to the specification may result. Therefore, in these rare situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.
44. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621